

REMARKS/ARGUMENTS

Applicant thanks the Examiner for the careful examination given to the present application. The application has been reviewed in light of the Office action, and it is respectfully submitted that the application as amended is patentable over the art of record.

Claims 8-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dingwall et al. (WO 93/23767) in view of Vercellotti et al. (U.S. Patent No. 5,266,925). For the following reasons, the examiner's rejection is respectfully traversed.

None of the references teach or suggest a "label identification step of identifying the said labels by successively reading the code of each of the said labels whilst temporarily inhibiting the other labels which are not yet identified" as recited in claim 8. The office action admits that Dingwall is silent these elements, but cites Vercellotti as teaching such label identification step.

In Vercellotti, the labels or tags are always requested to provide their entire code regardless of their number in the field of interrogation is (col. 3, lines 42-49). When several labels are present, Vercellotti teaches to bisect the numeric span of the codes that are interrogated, and the labels having a code falling outside the remaining span are not interrogated (col. 3, lines 49-55; col. 4, lines 37-53). This Vercellotti method does not amount or suggest to a temporary inhibition in an analytic identifying process, as in the claim invention, in which the codes are read. Vercellotti indicates that the labels are programmed to provide their code or to remain silent according to whether the code is higher or lower than a threshold A (col. 3, lines 60-63). In Vercellotti, this process involves an emitting of the threshold and a comparison with the code which is made in the label (col. 4, line 10-36). These operations slow the identification pace (col. 4, line 37, to col. 5, line 20), however, Vercellotti does not suggest implementing the isolation

method in any other different analytic identifying process. Therefore, Vercellotti does not disclose or suggest the identifying the labels by successively reading the code of each of the labels which temporarily inhibits the other labels which are not yet identified. Thus, even if combined, the references do not disclose or suggest all the elements of the claimed invention.

Furthermore, there is no suggestion or motivation for one skilled in the art at the time the invention was made to combine Dingwall with Vercellotti to arrive at the claimed invention. The mere fact that the references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP §2143.01; *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Dingwall discloses a system that identifies coded articles 30 by a search sequence. In Dingwall, the interrogator inhibits each article after it is identified so that one-by-one each of the remaining articles are also identified. All the labels, which are not yet identified, remain active during this identification process (page 19, lines 20 to 25).

There is no suggestion or motivation in Dingwall to replace this search sequence with a different identification process. Therefore, there is no motivation to look at or use the identification processes in Vercellotti. The desirability of modifying a label identification process is found only in the Applicant's own description of the invention, in contrast to the requirement that the teaching or suggestion to make the modification must be found in the prior art, and not based on an applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Reconsideration and withdrawal of the rejection based upon the combination of references is respectfully requested.

With respect to claim 9, none of the references disclose or suggest a "a label identification confirmation step, which precedes and influences the information passage step, comprising the sending of a signal containing at least part of the code of the label which has just been identified" as recited in claim 9. Neither Dingwall nor Vercellotti disclose or suggest a process in which the labels emit the entire code and a process in which the code is read by fragments, especially as in the present claim in which a definite order is recited. The entire code emission is not restricted to a prior step in Vercellotti, but it is present in all the Vercellotti identification steps. Therefore, even if combined, the references do not disclose or suggest all the elements of the claimed invention.

With respect to claim 10, none of the references make it obvious to conduct the code reading either in one direction or in the opposite direction. Beginning with one end or the other end of the code may be a matter of free choice for the technician, but the references do not suggest to shift the reading direction in order not to favorize the codes according to their value. In the present invention, the reading direction is switched whenever one label is identified. This is helpful for limiting the risks of undetection when the labels do not stay long in the filed of interrogation. Thus, even if combined, the references do not disclose or suggest all the elements of the claimed invention.

Claims 11-12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dingwall in view of Marsh et al. (EP Pub. 0494114 A2). For the following reasons, the examiner's rejection is respectfully traversed.

With respect to claim 11, Marsh does not teach a process in which label codes are demanded by fragments, but in which the label codes are emitted repeatedly at random times (see

Abstract) to decrease the risks of signal interferences with other labels. Moreover, the references do not indicate that the interrogation apparatus comprises a signal catalogue in which at least one of the labels is required to send its entire code. Marsh discloses a passive apparatus which does not interrogate and merely receives signals emitted by the labels. Therefore, even if combined, the references do not disclose or suggest all the elements of the claimed invention.

With respect to claim 12, Dingwall teaches an interrogation apparatus which requires label codes to always be in the same order or reading direction. Nothing in Dingwall suggests that it could be of interest to require the reading of the codes alternatively in one direction and in the opposite direction. Thus, even if combined, the references do not disclose or suggest all the elements of the claimed invention.

Furthermore, there is no suggestion or motivation for one skilled in the art at the time the invention was made to combine Dingwall with Marsh to arrive at the claimed invention. The mere fact that the references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

Dingwall discloses a system that identifies coded articles 30 by a search sequence. In Dingwall, the interrogator inhibits each article after it is identified so that one-by-one each of the remaining articles are also identified. There is no suggestion or motivation in Dingwall to have a signal catalogue or signals for requiring the codes to be read in a particular direction. Therefore, there is no motivation to look at or use the response signals in Marsh. The desirability of modifying the system to include a signal catalogue and reading direction signal is found only in the Applicant's own description of the invention, in contrast to the requirement that the teaching or suggestion to make the modification must be found in the prior art, and not based on an

Appl. No. 09/319,626
Amdt. Dated June 4, 2003
Reply to Office action of December 5, 2002


applicant's disclosure. Reconsideration and withdrawal of the rejection based upon the combination of references is respectfully requested.

In light of the foregoing, it is submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the application.

If there are any additional fees resulting from this communication, please charge the same to our Deposit Account No. 16-0820, our Order No. 31767.

Respectfully submitted,
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Date: June 4, 2003